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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/839,158

Applicant(s)

KAWAMOTO ET AL.

Examiner

Vincent Rudolph

Art Unit

2625

Period for Reply -- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43,45,49,51,73,74,77,78,81,82 and 84-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43,45,49,51,73,74,77,78,81,82 and 84-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notes of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/2/2008 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 43, 45, 49, 51, 73, 77 and 84-85 are rejected under the judicially created doctrine of obviousness-type double-patenting as being unpatentable over claims 1 and

5 of Aritomi (U.S. Patent No. 7,253,911) in view of Hicks (U.S. Patent No. 5,481,353). Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application and the combined patents disclose outputting data using a print-out format according to the setting of a first mode and a plurality of different print-out formats according to the setting of a second mode.

Regarding present claim 43, patented claim 5 of U.S. Patent No. 7,253,911 discloses setting through the Graphical User Interface a single print job that whenever it executes the selected mode, it produces a first data including presentation material and a second data including distribution material that outputs multiple copies as well as includes specific command for each data and finally output the data using the print device. While the patent claim 5 discloses a second data, it doesn't claim it is selected from a plurality of different data. Hicks discloses inputting supporting documents in addition to the presentation documents (as shown in **Figure 3**). The present claim claims a print-out format according to a setting using the first mode and a plurality of different print-out formats according to a setting using the second mode. It would have been obvious to have multiple supporting documents within claim 1 of Artitomi and combine it with Hicks since they both relate to producing, combining and outputting multiple documents formats through a single print job and provides a user to be able to select from multiple output features for outputting single print job. And it would have been obvious to have the modes as different data of the combined patented claims since they all relate to different print-out formats as well as including a command part for describing the group of job commands and the included print data. Even though the

combined patents claim this information within a printing device, it would have been obvious to have this information within the information processing apparatus in order for the print device to determine the data being sent. Therefore, each limitation claimed in the present claim 43 is broader than the corresponding limitation within the patented claim 5 of Aritomi (U.S. Patent No. 7,253,911) in view of Hicks (U.S. Patent No. 5,481,353).

In view of this, it is noted that allowing the present claim 43 would result in an unjustified or improper timewise extension of the "right to exclude" granted by a patent.

Regarding present claim 45 for having one format in which one page is printed out onto one sheet and another format in which a plurality of pages are printed out on one sheet, patented claim 5 claims that the presentation material is printed onto one page, but the distribution material is able to have multiple pages printed onto a single page using the N-in-1 layout.

Regarding present claims 49 and 51, patented claim 1 of Aritomi (U.S. Patent No. 7,253,911) in view of Hicks (U.S. Patent No. 5,481,353) claims a method for executing the processes claimed in patented claim 5 of Aritomi (U.S. Patent No. 7,253,911) in view of Hicks (U.S. Patent No. 5,481,353) as disclosed above in claims 43 and 45.

Regarding present claim 73, patented claim 5 of Aritomi (U.S. Patent No. 7,253,911) in view of Hicks (U.S. Patent No. 5,481,353) claims the same rationale as disclosed within claim 43 above, except instead of a first mode and second mode, the present claim claims the output formats as a first print setting and a second print setting.

Regarding present claim 77, patented claim 1 of Aritomi (U.S. Patent No. 7,253,911) in view of Hicks (U.S. Patent No. 5,481,353) claims a method for executing the processes claimed in claim 5 of Aritomi (U.S. Patent No. 7,253,911) in view of Hicks (U.S. Patent No. 5,481,353) as disclosed above in claim 73.

Regarding present claim 84, patented claim 5 of Aritomi (U.S. Patent No. 7,253,911) in view of Hicks (U.S. Patent No. 5,481,353) claims a printing system for receiving and executing the processes claimed in claim 5 of Aritomi (U.S. Patent No. 7,253,911) in view of Hicks (U.S. Patent No. 5,481,353) as disclosed above in claim 43.

Regarding claim 85, patented claim 1 of Aritomi (U.S. Patent No. 7,253,911) in view of Hicks (U.S. Patent No. 5,481,353) claims a method for executing the processes claimed in claim 5 of Aritomi (U.S. Patent No. 7,253,911) in view of Hicks (U.S. Patent No. 5,481,353) as disclosed above in claim 84.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43, 45, 49, 51, 73-74, 77-78, 81-82 and 84-86 are rejected under 35 U.S.C. 103(a) as being anticipated by Livingston ('632) in view of Hicks ('353).

Regarding claim 43, Livingston ('632) discloses an information processing apparatus (computer, **See Figure 1, Element 100**) capable of communicating with a printing apparatus (printer, **See Figure 1, Element 102**) for executing a printing

operation (**See Col. 3, Line 43-46**) and includes a setting means (the computer performs the action, thus it becomes the means) for setting, via a GUI in the information processing apparatus (an application program, **See Col. 3, Line 54-55**), a print-out format for single print data in a mode using a plurality of different formats for one piece of data (user is able to select different features for outputting the print data, **See Col. 4, Line 65-Col. 5, Line 4**), producing means for producing a print job to be printed by the printing apparatus in accordance with the setting means (receives the information from the user in order to produce the print job, **See Col. 9, Line 19-21**), the print job includes a command part describing a group of job commands (features to the page that is to be printed, **See Col. 4, Line 52-57**) and a print data part describing print data by a print language (imaging operation done by a printer driver for printing, **See Col. 9, Line 24-30**), and a sending means for sending the print job produced to the printing apparatus (sends the print job through the print driver to the selected printer, **See Col. 9, Line 24-26**).

Livingston ('632) does not disclose a print-out format in a first mode and a plurality of different print-out formats in a second mode, such that the group of job commands described in the second mode include a print control command representing the second mode for enabling the printing apparatus to execute a printing operation of a plurality of different print-out formats from the single print data described in the print data so that the printing operation is executed in the printing apparatus for the print-out format from the single print data according to the setting in the first mode as well as for

the plurality of different print.-out formats from the single print data according to the setting in the second mode.

Hicks ('353) discloses a print-out format in a first mode (transparencies, **See Figure 3**) and a plurality of different print-out formats in a second mode (supporting sets, which include dividers, master set and hand out set, **See Figure 3**), such that the group of job commands described in the second mode include a print control command representing the second mode for enabling the printing apparatus to execute a printing operation of a plurality of different print-out formats from the single print data described in the print data (user selects the supporting sets to be included with the transparencies prior to outputting the data, **See Col. 7, Line 23-32**) so that once it is received in the printing apparatus, the printing operation outputs the print-out format according to the setting in the first mode from the single print data as well as the plurality of print-out formats according to the setting in the second mode from the single print data (whenever printing is ordered, the order for outputting the print-out formats in the first and second mode is determined and executed, **See Col. 10, Line 16-19**).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include different modes and the commands to include within it in order to process and output them, such as the one disclosed within Hicks ('353), and incorporate it into the information processing apparatus of Livingston ('632) because it enables a printer to understand the desired settings set by a user on the graphical user interface on the computer in order generate the document and output it accordingly.

Regarding claim 45, Livingston ('632) discloses that the plurality of different print-out formats includes one format where one page is printed out onto one sheet (such as duplex printing) and another format where a plurality of pages are printed out onto one sheet (printing multiple pages per sheet, **See Figure 3; Col. 4, Line 58-Col. 5, Line 4**).

Regarding claim 73, Livingston ('632) discloses an information processing apparatus (computer, **See Figure 1, Element 100**) capable of producing a print job to be printed by the printing apparatus (**See Col. 3, Line 43-46**), the print job including a command part (features to the page that is to be printed, **See Col. 4, Line 52-57**) and a print data part (imaging operation done by a printer driver for printing, **See Col. 9, Line 24-30**) and apparatus includes a user interface means (keyboard, **See Figure 1, Element 112**) for setting a print setting from the information processing apparatus so that the printing apparatus can output the print data included in the print job in an output format (user enters information to the application program so that it is able to be outputted to the printer, **See Col. 3, Line 54-58**), a setting means (the computer performs the action, thus it becomes the means) for setting the print control command to specify the output format on the print setting to the command part included in the print job so that the printing apparatus can output the print data included within the print job in the selected output format (user selecting any features to apply to any of the pages of print data, **See Col. 4, Line 52-57**), producing means for producing the print job including the command part and the print data part (receives the information from the user in order to produce the print job, **See Col. 9, Line 19-21**), and sending means for

sending the print job produced to the printing apparatus (sends the print job through the print driver to the selected printer, **See Col. 9, Line 24-26**).

Livingston ('632) does not disclose setting a first and a second print setting so that that print data included is in a first output format as well as a second output format and setting the first and second print control command for specifying the output formats based on the print setting respectively in order for the printing apparatus to output the print data included in the print job in the first output format based on the first print setting and the second output format based on the second print setting by using the print data part of the same print job.

Hicks ('353) discloses a first print-out format in a first print setting (transparencies, **See Figure 3**) and a second print-out format in a second print setting (supporting sets, which include dividers, master set and hand out set, **See Figure 3**), and sets the first and second print control command for specifying the output formats based on the print settings (user selects the supporting sets to be included with the transparencies, **See Col. 7, Line 23-32** as well as the options for both prior to outputting the data, **See Col. 7, Line 42-67**) so that the printing apparatus can receive the print data in the first and second output format (the transparencies and the selected supporting set and the order to output it, **See Figure 4; Col. 8, Line 19-25**) so that once it is received in the printing apparatus, the printing operation outputs the print-out format according to the first setting from the single print data as well as the plurality of print-out formats according to the second setting from the single print data by using the print data part of the same print job (whenever printing is ordered, the order for outputting the

print-out formats in the first and second mode is determined and executed, **See Col. 10, Line 16-19**, from the received print data of the same print job, **See Col. 9, Line 59-61**).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include different settings for different output formats and the commands to include within it in order to process and output them, such as the one disclosed within Hicks ('353), and incorporate it into the information processing apparatus of Livingston ('632) because it enables a printer to understand the desired settings set by a user on the graphical user interface on the computer in order generate the document and output it accordingly.

Regarding claim 74, Livingston ('632) discloses that the first output format and second output format are different N-up layout printings (different N-up layout for the preset class, **See Col. 8, Line 21-54**).

Regarding claim 84, Livingston ('632) discloses a printing system (**See Figure 1**) that includes an information processing apparatus (computer, **See Figure 1, Element 100**) and a printing apparatus (**See Figure 1, Element 102**) wherein the information processing apparatus and the printing apparatus are connected through a communication medium (input output port, **See Figure 1, Element 116; Col. 3, Line 57-58**), wherein the information processing apparatus includes a user interface means (keyboard, **See Figure 1, Element 112**) for setting a print setting from the information processing apparatus so that the printing apparatus can output the print data included in the print job in an output format (user enters information to the application program so that it is able to be outputted to the printer, **See Col. 3, Line 54-58**), a setting means

(the computer performs the action, thus it becomes the means) for setting a print control command to specify the output format on the print setting to the command part included in the print job so that the printing apparatus can output the print data included within the print job in the selected output format (user selecting any features to apply to any of the pages of print data, **See Col. 4, Line 52-57**), producing means for producing the print job including the command part and the print data part (receives the information from the user in order to produce the print job, **See Col. 9, Line 19-21**), and sending means for sending the print job produced to the printing apparatus (sends the print job through the print driver to the selected printer, **See Col. 9, Line 24-26**), and wherein the printing apparatus includes a receiving means (the printer performs the action, thus it becomes the means) for receiving the one print job including the command part and the print data part from the information processing apparatus (imaging device receives the data from the printer driver, **See Col. 9, Line 24-30**, such that it includes the print data document and the assigned feature selections for each page, **See Col. 9, Line 19-24**), producing means for producing the print image data from the print data part included in the one print job according with the interpretation of the command data (produces the imaging operation according to the values of each page received, **See Col. 9, Line 28-30**), printout performing means for performing a printout on a printing medium based on the print image data (a hardcopy is generated, **See Col. 3, Line 43-46**, from the print job data processed in the imaging device, **See Col. 9, Line 28-30**).

Livingston ('632) does not disclose setting a first and a second print setting so that that print data included is in a first output format as well as a second output format

and setting the first and second print control command for specifying the output formats based on the print setting respectively in order for the printing apparatus to produce and output the print data included in the print job in the first output format based on the first print setting in the command part and the second output format based on the second print setting in the command part.

Hicks ('353) discloses a first print-out format in a first print setting (transparencies, **See Figure 3**) and a second print-out format in a second print setting (supporting sets, which include dividers, master set and hand out set, **See Figure 3**), and sets the first and second print control command for specifying the output formats based on the print settings (user selects the supporting sets to be included with the transparencies, **See Col. 7, Line 23-32** as well as the options for both prior to outputting the data, **See Col. 7, Line 42-67**) so that the printing apparatus can receive the print data in the first and second output format (the transparencies and the selected supporting set and the order to output it, **See Figure 4; Col. 8, Line 19-25**) so that once it is received in the printing apparatus, the printing operation outputs the print-out format according to first print setting from the command part as well as the plurality of print-out formats according to the second print setting from the command part (whenever printing is ordered, the order for outputting the print-out formats in the first and second mode is determined and executed, **See Col. 10, Line 16-19**, from the received print data of the same print job, **See Col. 9, Line 59-61**, based on the command part, **See Col. 7, Line 23-30**, and the options of the first and second print setting, **See Figure 3; Col. 7, Line 42-67**).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include different settings for different output formats and the commands to include within it in order to receive, process and output them using a printer, such as the one disclosed within Hicks ('353), and incorporate it into the information processing apparatus of Livingston ('632) because it enables a printer to understand the desired settings set by a user on the graphical user interface on the computer in order generate the document and output it accordingly.

Regarding claims 49, 51, 77-78 and 85, the rationale provided in the rejection of claims 43, 45, 73-74 and 84 is incorporated herein. In addition, the apparatus of claims 43, 45 and 73-74 and the printing system of claim 84 corresponds to the method of claims 49, 51, 77-78 and 85 and performs the steps disclosed herein.

Regarding claim 81, Livingston ('632) discloses a computer readable medium storing a control program for implementing the method (**See Figure 1, Element 108**).

Regarding claims 82 and 86, the rationale provided in the rejection of claim 81 is incorporated herein. In addition, the method of claim 81 corresponds to the method of claims 82 and 86 and performs the steps disclosed herein.

Response to Arguments

Applicant argues that the claims have overcome the double patenting rejection based on the newly amended claims. Even though the amended claims overcome the Aritomi reference for obviousness-type double patenting, it does not overcome the Aritomi in view of Hicks for obviousness-type double patenting as disclosed within the

rejection above. As a result, the obviousness-type double patenting rejection is maintained.

Applicant argues that the prior art of Hicks does not disclose a group of job commands described in the second mode including a print control command representing the second mode for enabling the printing apparatus to execute a printing operation for multiple different print-out formats from the single print data. Hicks discloses that whenever a user select transparencies as a first print-out format in a first mode (**See Figure 2**), the user is able to select a plurality of different print-out formats as a second mode, such as Dividers, Master Set and/or Handout Set (**See Figure 3**). The user then enters a group of job commands for the second mode, such as whether to include any of the three print-out formats, color selection, inserting additional sheets, as well as the output sequence (**See Figure 3**), which is selected from the same print data used by the transparencies setting in the first mode, such as an image, that is duplicated to the supporting sets (**See Figure 4; Col. 8, Line 52-59**). Thus, when combined with Livingston, it enables the printer to understand the different setting modes set by a user on the graphical user interface on the computer in order generate the documents and output it accordingly. As a result, the combined prior art of Hicks and Livingston do meet the limitations of the amended claims.

Applicant also argues the prior art of Hicks does not disclosed whether the different print-out formats are printed by a single print job or plural print jobs, whether the print data item is one or plural, or how a command included in the print job changes depending on the print setting. Hicks discloses that the transparencies set includes

transparencies sets (first mode) as well as supporting sets, such as dividers, master sets and hand-out sets (second mode). Once the user selects the commands and print-out formats, the sequence is selected and the single print job is outputted (**See Col. 10, Line 14-19**). Hicks also discloses that the one print data is used within the plurality of different print-out formats, such as an image that is duplicated onto the other selected sets (**See Figure 4; Col. 8, Line 52-59**). Finally, Hicks discloses the command is used for the second mode within the transparencies setting, such as which sets are selected by the user and any specific features for the sets, such as color, additional sheets and the outputting sequence requested (**See Figure 3; Col. 7, Line 42-67**). As a result, when combined with Livingstone, the prior arts do meet the limitations of the amended claims.

The applicant's arguments with respect to the additional claims are met by Livingston in combination with Hicks as disclosed within the rejection above.

Based on these facts, **THIS ACTION IS MADE NON-FINAL.**

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent Rudolph whose telephone number is (571) 272-8243. The examiner can normally be reached on Monday through Friday 8 A.M. - 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vincent Rudolph
Examiner
Art Unit 2625

/Vincent Rudolph/
Examiner of Art Unit 2625

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